

REMARKS

Applicant has studied the Office Action dated February 4, 2005 and has made amendments to the claims. Claims 12-14 have been amended. Claims 12-14 and 20 are pending. Claims 12 and 20 are independent claims.

The amendments to claims 13 and 14 are intended to more clearly disclose the invention and are not related to patentability. No new matter has been added. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

Objections

The Examiner objected to informalities in the claims. Specifically, the Examiner asserted that previous amendments to claims 13 and 14 to change the phrase “first magnet” to “second magnet” were not reflected in the most recent response sent to the PTO since both claims still recite “first magnet.” With this paper, claims 13 and 14 have been changed to recite “second” instead of “first” in order to reflect the latest version of the claims. Applicant respectfully asserts that the grounds for objection have been overcome and requests that the objection be withdrawn.

§112 Rejections

The Examiner rejected claims 12-14 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner asserted that the phrases “moving coil system” and “moving magnet system” in claim 12 are indefinite in view of the knowledge in the art in that the magnets of the recited system are part of the respective “moving magnet system” and “moving coil system” and that claims 13 and 14 are rejected based on their dependence from claim 12. With this paper, claim 12 has been amended to recite a “moving coil principle” and a “moving magnet principle” in order to describe the novelty of the present invention in that, although the structure of the apparatus may not be a conventional “moving coil system” and “moving magnet system,” the principle by which the system operates is based on a “moving coil” and a “moving magnet.” Therefore, Applicant respectfully asserts that the grounds for the rejection have been overcome and requests that the rejection be withdrawn.

The Examiner rejected claims 12-14 under 35 U.S.C. § 112, second paragraph, as incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. Specifically, the Examiner asserted that the structural cooperative relationship in claim 12 between the “first magnet means” and the “second magnet means” has been omitted and that claims 13 and 14 are rejected based on their dependence from claim 12. With this paper, claim 12 has been amended to more accurately disclose the structure of the “first means” and the “second means” and to recite the cooperative relationship between the “first means” and the “second means” in the “wherein clause.” Applicant respectfully asserts that the grounds for the rejection have been overcome and requests that the rejection be withdrawn.

§ 103 Rejection

Claims 12-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Takishima (U.S. Patent No. 6,515,947) in view of Nagasato (U.S. Patent No. 6,181,670). This rejection is respectfully traversed.

As was previously indicated, with this paper, independent claim 12 has been amended to recite the cooperative relationship between a first means and second means. Specifically, claim 12 has been amended to recite that current flows through the radial coil and tangential coil to generate a force for driving the first means and magnetic flux is generated at the radial coil and tangential coil by a magnetic circuit formed by the first magnet and second magnet. Support for the amendment is found in the specification as originally filed at page 10, line 10 to page 11, line 24. It is respectfully submitted that neither Takishima nor Nagasato disclose this limitation.

It is respectfully noted that the Federal Circuit has provided that an Examiner must establish a case of prima facie obviousness. Otherwise the rejection is incorrect and must be overturned. As the court stated in In re Rijkenaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993):

“In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. ‘A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.’ If the examiner

fails to establish a prima facie case, the rejection is improper and will be overturned.” (citations omitted.)

It is respectfully noted that the Examiner states, at paragraph 7 of the Office action, that Takishima “does not disclose second magnet means operated by a moving magnet system” and, therefore, it is respectfully submitted that Takishima fails to disclose the second means operated according to a moving magnet principle recited in claim 12. It is further respectfully submitted that Nagasato fails to disclose the first means operated according to a moving coil principle recited in claim 12. Moreover, it is respectfully submitted that the cooperative relationship recited in claim 12 between the first means and second means, specifically that current flows through the radial coil and tangential coil to generate a force for driving the first means and magnetic flux is generated at the radial coil and tangential coil by a magnetic circuit formed by the first magnet and second magnet, would not be obvious to one of ordinary skill in the art from the individual teachings of the Takishima and Nagasato references, neither of which discloses both the first means and second means.

It is respectfully asserted that independent claim 12 is allowable over the cited references. It is further respectfully asserted that claims 13 and 14, which depend from claim 12, also are allowable over the cited references.

Allowable Subject Matter

Applicant graciously acknowledges the Examiner’s allowance of claim 20. Since claim 20 has not been amended with this paper, Applicant believes that the claim is still in condition for allowance.



CONCLUSION

In light of the above remarks, applicants submit that the present Amendment places claims 12-14 and 20 of the present application in condition for allowance. Reexamination and reconsideration of the application, as amended, are requested.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623-2221 to discuss the steps necessary for placing the application in condition for allowance.

Date: June 3, 2005

Respectfully submitted,

LEE, HONG, DEGERMAN, KANG & SCHMADEKA

By:

A handwritten signature in black ink, appearing to read "RC Salfelder".

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